

SUPPORT FOR THE AMENDMENTS

The present amendment amends claims 22 and 23, and adds new claims 34-36.

Support for the amendment to claim 22 is found in the specification and claims as originally filed.

Support for the amendment to claim 23 is found at specification page 4, lines 7-19, page 5, lines 35-39, and page 6, lines 1 and 28-32.

Support for newly added claims 34-36 is found at specification page 8, lines 25-38, page 9, lines 1-2, and page 11, lines 9-19.

It is believed that these amendments have not resulted in the introduction of new matter.

REMARKS

Claims 22-36 are currently pending in the present application. Claims 22 and 23 have been amended, and new claims 34-36 have been added, by the present amendment.

The rejection of claims 22-33 under 35 U.S.C. § 103(a) as being obvious over Rostami (WO00/29480 and U.S. Patent 6,689,832, which is the English language equivalent thereof) in view of Fraser (U.S. Patent 6,172,135) is obviated by amendment, with respect to claims 22-36, which incorporates the transitional phrases “consists essentially of” into amended claim 22.

Amended claim 22 recites an impact-modified polymethyl methacrylate molding composition resistant to hot water cycles, wherein the impact-modified polymethyl methacrylate molding composition *consists essentially of*: (1) from 70 wt. % to 99 wt. % of a polymethyl methacrylate matrix composition having an average molar mass molecular weight of from 130,000 g/mol to 190,000 g/mol, wherein the polymethyl methacrylate matrix composition *consists essentially of*: (a) from 80 wt. % to 99.5 wt. % methyl methacrylate; and (b) from 0.5 wt. % to 20.0 wt. % vinylic comonomer; and (2) from 1 wt. % to 15 wt. % of an impact-modifier composition in the form of a crosslinked elastomeric particle, wherein the impact-modifier composition *consists essentially of*: (a) from 50 wt. % to 70 wt. % methyl methacrylate; (b) from 20 wt. % to 40 wt. % butyl acrylate, butadiene, or both; (c) from 0.1 wt. % to 2 wt. % allyl methacrylate; and (d) from 0.5 wt. % to 5 wt. % vinylic comonomer.

Amended claim 22 recites the transitional phrases “consists essentially of” thereby limiting the scope of the impact-modified polymethyl methacrylate molding composition to the materials specified therein and to those materials that do not materially effect the basic and novel characteristic thereof. See e.g., MPEP § 2111.03.

As discussed in the present specification and evidenced by the scientific experimental data presented therein (See e.g., page 3, lines 9-17, page 10, lines 4-7, and page 11, lines 21-

24), Applicants have discovered that the claimed impact-modified polymethyl methacrylate molding composition exhibits superior properties with respect to high surface quality and excellent resistance to hot water cycles, cracking, scratching, and scoring.

Rostami describes an acrylic copolymer composition that necessarily contains mineral filler in substantial amounts of from 10 to 80 wt. % (See e.g., column 1, lines 42-44 and 54-56, column 2, lines 38-45).

Applicants submit that the presence of substantial amounts of mineral filler such as those described in Rostami would materially effect the basic and novel characteristics of the claimed composition by negatively effecting various properties thereof, including, for example, surface quality and resistance to hot water cycles, cracking, scratching, and scoring.

It is well understood by skilled artisans that the presence of substantial amounts of mineral filler within a thermoplastic composition deleteriously effects the properties thereof by increasing surface roughness and oftentimes severely decreasing moisture resistance and impact strength, as evidenced by Ancker (U.S. Patent 4,795,768, a copy of which is enclosed herewith for the Examiner's convenience) (See e.g., column 1, lines 30-49, column 3, lines 3-9, column 4, lines 60-68, column 5, lines 1-6, 23-42 and 52-68, column 6, lines 19-33 and 59-68, column 7, lines 1-2). Ancker attempts to address the deleterious effects associated with including substantial amounts of mineral filler by incorporating interface agents into the thermoplastic composition (See e.g., column 6, lines 19-33). As duly noted by Ancker, the actual selection of particular interface agents for circumventing the negative effects attributable to the presence of substantial amounts of mineral filler within particular mineral filler/resin systems is not understood or predictable by skilled artisans (See e.g., column 6, lines 32 and 33).

Applicants respectfully submit that the burden of showing that the introduction of substantial amounts of mineral filler, which is necessarily present within the acrylic

copolymer composition of Rostami, would materially effect the basic and novel characteristics of the claimed composition by negatively effecting the properties thereof has already been met for at least the following two reasons. First, as evidenced by Ancker, it is well understood by skilled artisans that the presence of substantial amounts of mineral filler within a thermoplastic composition deleteriously effects the properties thereof. Second, Applicants have discovered that the claimed impact-modified polymethyl methacrylate molding composition exhibits superior properties with respect to high surface quality and excellent resistance to hot water cycles, cracking, scratching, and scoring, as discussed in the present specification and evidenced by the scientific experimental data presented therein.

In accordance with *In re De Lajarte*, 143 USPQ 256, 258 and 259 (C.C.P.A. 1964) (enclosed herewith for the Examiner's convenience), *requiring the submission of comparative evidence* in the form of a 37 C.F.R. § 1.132 Declaration demonstrating that the introduction of such substantial amounts of mineral filler that is necessarily present within the acrylic copolymer composition of Rostami would materially effect the basic and novel characteristics of the claimed composition by negatively effecting the properties thereof *would impose an unjustifiable burden on the Applicants* since it is well understood by skilled artisans that the presence of substantial amounts of mineral filler within a thermoplastic composition deleteriously effects the properties thereof, and Applicants have already demonstrated in the present specification and the scientific experimental data presented therein that the claimed impact-modified polymethyl methacrylate molding composition exhibits superior properties.

Since the presently claimed impact-modified polymethyl methacrylate molding composition excludes the presence of the requisite 10-80 wt. % mineral filler that is necessarily present within the acrylic copolymer composition of Rostami because such a substantial amount of mineral filler would materially effect the basic and novel characteristics

of the claimed invention, the impact-modified polymethyl methacrylate molding composition of the present invention is *fundamentally different* from the acrylic copolymer composition of Rostami.

While Rostami describes an acrylic copolymer composition further comprising 1-50 wt. % of an MBS toughening agent (See e.g., column 2, lines 58-65), Rostami fails to describe the specific weight percents of the various components within the MBS toughening agent, as acknowledged on page 5, lines 1-3, of the Official Action dated August 10, 2007.

Amended claim 22 recites, in part, an impact-modifier composition consisting essentially of: (a) from 50 wt. % to 70 wt. % methyl methacrylate; (b) from 20 wt. % to 40 wt. % butyl acrylate, butadiene, or both; (c) from 0.1 wt. % to 2 wt. % allyl methacrylate; and (d) from 0.5 wt. % to 5 wt. % vinylic comonomer. Claim 25 recites that the vinylic comonomer is an alkyl methacrylate selected from one or more C₁-C₄ alkyl methacrylates. Therefore, methyl methacrylate is present within the claimed impact-modifier composition in an amount of 50-75 wt. %, when the vinylic comonomer is methyl methacrylate.

Fraser describes an impact-modified (meth)acrylic polymer composition comprising an impact-modifier composition in the form of a core-shell crosslinked particle, wherein the core comprises 80-99 wt. % methyl methacrylate and 1-20 wt. % C₁-C₄ alkyl acrylate (e.g., butyl acrylate), and the shell comprises 0-25 wt. % styrene and 75-100 wt. % (meth)acrylate (See e.g., column 3, lines 46-50 and 59-60, column 4, lines 8-11, 20-21, 54 and 64-67, column 5, lines 1-7, 26-32 and 41-47, column 9, lines 21-30, and claims 1-7 and 12-18).

As a result, the amount of methyl methacrylate present within the impact-modifier composition of Fraser, including the preferred embodiment described therein (See e.g., column 9, lines 21-30), is *clearly outside* the claimed range of 50-75 wt. % methyl methacrylate.

Claims 28 and 29 recite that the impact-modified polymethyl methacrylate molding composition exhibits a flowability of about 10.0 cm³/10 minutes and a vicat softening temperature of greater than 105°C, respectively.

Rostami fails to describe the flowability and the vicat softening temperature of the acrylic copolymer composition. Fraser likewise fails to describe the flowability and the vicat softening temperature of the impact-modified (meth)acrylic polymer composition.

A skilled artisan would reasonably expect that the acrylic copolymer composition of Rostami, when combined with the impact-modifier composition of Fraser, would actually possess a different flowability and vicat softening temperature than those claimed. This is especially the case since the presently claimed impact-modified polymethyl methacrylate molding composition excludes the presence of the requisite 10-80 wt. % mineral filler that is necessarily present in substantial amounts within the acrylic copolymer composition of Rostami.

In conclusion, the impact-modified polymethyl methacrylate molding composition of the present invention is fundamentally different from the resultant impact-modified acrylic copolymer composition of Rostami in view of Fraser.

Withdrawal of this ground of rejection is respectfully requested.

The rejection of claims 23-26 under 35 U.S.C. § 112, second paragraph, is obviated by the amendment to claim 23. Withdrawal of this ground of rejection is respectfully requested.


The objection of claim 22 is respectfully traversed. Claim 22 is objected to on page 2 of the Official Action because the total wt. % of components 1) and 2) does not necessarily constitute 100 wt. % of the claimed impact-modified polymethyl methacrylate molding composition. As duly noted in the Official Action, the total wt. % of polymethyl methacrylate matrix composition 1) and impact-modifier composition 2) need not necessarily

constitute 100 wt. % of the claimed impact-modified polymethyl methacrylate molding composition. Moreover, Applicants submit that up to 29 wt. % of one or more additional components may in fact be included within the claimed impact-modified polymethyl methacrylate molding composition, so long as these additional components do not materially change the basic and novel characteristics of the claimed invention. Withdrawal of this ground of objection is respectfully requested.

In conclusion, Applicants submit that the present application is now in condition for allowance and notification to this effect is earnestly solicited.

Respectfully submitted,

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143 USPQ 256

In re DE LAJARTE

U.S. Court of Customs and Patent Appeals

Appl. No. 7237

Decided November 5, 1964

337 F2d 870

Headnotes

PATENTS

[1] Claims--"Comprising," "Consisting," etc. (► 20.30)

Patentability--Composition of matter (► 51.30)

Where claims are directed to glass composition and applicant contends that two *modifying* components in reference composition are excluded by claim's words "consisting essentially of," applicant has burden of showing the basic or novel characteristics of his glass, i.e., of showing that introduction of these two components would materially change characteristics of applicant's glass; burden is met by pointing out in specification and claims the great increase in desired properties resulting from his glass.

[2] Patentability--Composition of matter (► 51.30)

Pleading and practice in Patent Office--In general (► 54.1)

In total absence of evidence to indicate that glass disclosed by reference would be expected to have desirable insulating properties, there is no justification for placing burden on applicant to conduct experiments to determine insulating properties of such glass; it cannot be assumed that small differences between reference's glass and applicant's glass are incapable of causing a difference in properties; by showing that his glass has basic and novel properties, applicant has met his burden.

[3] Patentability--Composition of matter (► 51.30)

Specification--Sufficiency of disclosure (► 62.7)

Cases cited in support of position that, in order for range claimed by applicant to be critical, range must be disclosed as being critical, are not applicable in instant case since issue involved is anticipation under 35 U.S.C. 102, not obviousness.

Particular Patents

Particular patents--Glass

De Lajarte, Glass Compositions, claims 5 and 11 of application allowed.

Case History and Disposition

Appeal from Board of Appeals of the Patent Office.

Application for patent of Stephane Dufaure De Lajarte, Serial No. 669,956, filed July 5, 1957; Patent Office Division 56. From decision rejecting claims 5 and 11, applicant appeals. Reversed.

Attorneys

JOHN L. SEYMOUR and BAUER & SEYMOUR, both of New York, N.Y., for appellant.

CLARENCE W. MOORE (GEORGE C. ROEMING of counsel) for Commissioner of Patents.

Judge

Before RICH, Acting Chief Judge, MARTIN, SMITH, and ALMOND, Associate Judges, and KIRKPATRICK, Judge. *

* United States Senior Judge for the Eastern District of Pennsylvania, designated to participate in place of Chief Judge Worley, pursuant to provisions of Section 294(d), Title 28, United States Code.

Opinion Text

Opinion By:

ALMOND, Judge.

Stephane Dufaure De Lajarte appeals from a decision of the Board of Appeals affirming the examiner's rejection of all of the claims in appellant's application ¹for a glass composition.

¹ Serial No. 669,956, filed July 5, 1957, for "Glass Compositions."

The rejected claims 5 and 11 read as follows:

5. Electrically insulating glass having a composition consisting essentially of the following constituents in per cent by weight

Table set at this point is not available. See table in hard copy or call BNA at 1-800-372-1033.

said glass having resistance to perforation equivalent to at least about 36 KV in a plate 500 x 500 x 7 mm., at 200° C., under 50 cycle alternating current.

11. Electrically resistant glass, in particular for glass insulators, having a resistance to perforation equivalent to at least about 20 K.V. in a plate 500 x 500 x 7 mm. at 200° C., under sine wave current of 50 periods, and having a composition consisting essentially of

Table set at this point is not available. See table in hard copy or call BNA at 1-800-372-1033.

Appellant indicates that the intended use of his glass is as an electrical insulator. Glass suitable for such use must have high resistance to perforation by high-voltage electric current, particularly when the glass

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is hot. Appellant states that insulator glass must also maintain its resistivity at high temperatures, have good chemical durability under conditions of use and be free of devitrified or crystalline particles. He alleges that a glass having all of the desired properties can be obtained by making a glass having the composition set forth in the claims. It can be seen from 11 that a rather intricate relationship between components is specified. For example, the amount of Al_2O_3 present must be below 8% but not until the exact amount of Al_2O_3 is determined can the limits on SiO_2 and Na_2O be set. The amount of K_2O may vary from 1 to 4% but the permissible range of K_2O is not determined until the amount of Na_2O is established.

In his application, appellant compares what is described as "a prior art glass of a standard composition for electrical insulators" with glasses which conform to the composition set forth in the claims. The prior art glass contains 69% SiO_2 , 1.5% Al_2O_3 , 14.5% Na_2O , 0.3% K_2O , 11.3% CaO , 1.5% MgO , 1.3% Fe_2O_3 , and 0.6% MnO . It can be seen that this composition varies from that set forth in claim 11 in containing more than 11% Na_2O and less than 1% K_2O . The prior art glass had a resistance to perforation of 14 KV in a plate 500 x 500 x 7mm., at 200° C., under 50 cycle alternating current. The three glasses having compositions according to the claims have resistances of 24.5 KV, 31 KV, and 36 KV.

The sole reference is:

Table set at this point is not available. See table in hard copy or call BNA at 1-800-372-1033.

The stated object of Lyle is to produce an amber glass of pleasing color and good chemical durability. Amber color is obtained by the addition of carbon and sulfur. Lyle states that:

Prior amber glass of the reduced or carbon-sulfur is notoriously unstable and such stability as is attained is often transitory. This is to be expected from the combustibility of the basic coloring materials, carbon and sulfur. Consequently, such glass, which is properly colored when partially melted, may lose color and may blister and foam as melting and fining proceeds and may become unfit for use if held very long at high temperatures.

To solve this problem, Lyle uses a composition having the following relation: $S - 2N = K$ where S is the weight percentage of silica, N is the weight percentage of alkali and K is a constant ranging from 45 to 60. In Table I Lyle sets forth several examples of his amber glass including the following composition

Table set at this point is not available. See table in hard copy or call BNA at 1-800-372-1033.

The above glass was made from a batch having the following composition:

Table set at this point is not available. See table in hard copy or call BNA at 1-800-372-1033.

Lyle states that the percentages of sulfur and carbon were omitted from Table I and that sulfur in A was supplied by barytes in the batch.

The examiner, in his letter of May 8, 1958, stated that Lyle "teaches a glass composition consisting essentially of the same oxides and proportions as claimed by applicant, note Table I, composition A * * *." The examiner contended in the Final Rejection of November 18, 1959 and in his Answer that the claims were directly readable on the composition of Lyle. This language would seem to indicate that the statutory basis of the rejection is 35 U.S.C. 102. The board,

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however, talked about critical difference which could indicate 103. The solicitor, at oral argument, declared that he did not know what the ground of rejection was and refused to rely upon either 35 U.S.C. 102 or 103 alone. Apparently, then, both sections must be considered.

The examiner's intended rejection was apparently a "102 rejection," despite the actual differences which

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exist between Lyle and the claimed composition. In the Examiner's Answer, the 1% K₂O limitation of the claims was treated as follows:

The composition of Lyle would include the proportional limitation relationship of K₂O and Na₂O as recited in appellant's claim since it is noted in Table II, Composition A, that nepheline syenite is employed as the raw batch constituent for supplying K₂O in the final glass composition A, Table I. In the analysis of nepheline syenite, K₂O is present in amounts of more than 5%.

Therefore, in Lyle's composition, since .05 of the combined Na₂O and K₂O total is K₂O, the amount of K₂O is calculated to be about 1 percent of the total glass composition, thus falling within the range limitation of K₂O (1-4%) recited in appellant's claims.

The fact that Lyle contains sulfur and carbon in addition to the components specified by the claims was not commented upon by the examiner.

The Board of Appeals *affirmed* the examiner but admitted that Lyle did not necessarily disclose a glass containing 1% K₂O in stating:

We note that Lyle discloses, particularly in Example A (table II in column 3), that a substantial amount of nepheline syenite is employed in preparing the glass. Although it cannot be regarded as certain as to exactly how much potassium is introduced into the glass composition thereby, there does not appear to be any doubt that the glass composition includes potassium. We find no evidence that there is any critical difference between the amount of potassium in the glass compositions of Lyle and the minimum of 1% specified in claim 11.

The board, as did the examiner, failed to comment upon the sulfur present in Lyle's composition. With regard to carbon, the board stated:

Lyle discloses that a very small amount of carbon, less than 1/2 of 1%, is employed in the preparation of his glass composition A. In our opinion, it would not be expected that the presence of this small amount of carbon would substantially alter the electrical resistance of the glass composition. Claim 11 which recites "consisting essentially of" the named ingredients does not exclude small amounts of other materials which do not change the essential character of the composition. In our opinion, it must also be considered that some of the charcoal employed by Lyle may be lost due to atmospheric oxidation during the preparation of the final glass. In the absence of a factual showing of a critical difference in the electrical resistance of applicant's glass composition as compared to that of the compositions taught by Lyle, we are of the view that claim 11 does not patentably distinguish from the reference.

[1] Appellant contends that his claims are not anticipated by the Lyle reference because (1) Lyle's composition contains sulfur and carbon which are excluded from appellant's composition by the words "consisting essentially of" and (2) Lyle's composition does not meet the 1% K₂O limitation recited in appellant's claims. We will first consider the carbon and sulfur question. Appellant and the solicitor agree that the issue is whether the introduction of sulfur and carbon would materially change the characteristics of appellant's insulating glass. The solicitor would put the burden of showing a material change on the appellant. The effect of "consisting essentially of" was considered in *In re Janakirama-Rao*, 50 CCPA 1312, 317 F.2d 951, 137 USPQ 893, where, as in the present case, the claims were directed to a glass composition and the reference contained some *modifying* components in addition to those claimed by appellant. The court found that appellant's glass had no basic or novel characteristics and thus did not distinguish over the reference. Thus, here appellant has the burden of showing the basic or novel characteristics of his insulating glass. He has met his burden by pointing out in his specification and claims the great increase in resistance to perforation resulting from his composition.

The Board of Appeals and the solicitor contend that appellant has furnished no evidence that a critical difference in appellant's emphasized characteristics would result from the introduction of small amounts of

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Lyle's coloring agents, charcoal and sulfur. It is not clear what evidence they would require. The solicitor has noted that an affidavit which the board did not consider contains nothing significant on this issue. It may

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be implied that the Patent Office would require appellant to duplicate the Lyle glass and compare its resistance to perforation with that of appellant's glass.

[2] In the total absence of evidence in the record to indicate that the amber glass disclosed by Lyle would be expected to have desirable electrical insulating properties, we can find no justification for placing the burden on applicant to conduct experiments to determine the insulating properties of the colored glass disclosed by Lyle. Although there are only very slight differences between the Lyle composition and that sought to be patented, we cannot assume that these small differences are incapable of causing a difference in properties. Appellant, in showing that his glass has basic and novel properties (at least as far as the record is concerned), would appear to have met his burden.

Another difference between appellant's glass and the Lyle glass is the K_2O content. Claim 11 calls for 1 to 4% K_2O . Lyle uses nepheline syenite, a K_2O -containing rock, in forming his glass. The amount of K_2O in the nepheline syenite apparently may vary greatly and thus it is impossible to say just how much K_2O is present in the Lyle composition. Appellant contends that at least one type of nepheline syenite will introduce only 0.6% K_2O into the composition. The solicitor apparently concedes that the amount of K_2O is uncertain. His position is, however, that even 0.6% is enough to meet the claims because there is no proof that the range of 1 to 4% is critical. There is no indication in the record that the examiner ever questioned the criticality of the range. The question was apparently first raised by the board. After the board's decision, appellant filed an affidavit attempting to establish the criticality of the 1-4% range. The board refused to consider the affidavit on the basis that no new rejection had been made and that the affidavit was not filed in time. The appellant does not dispute that ruling here.

[3] In support of his position that in order for a claimed range to be critical the range must be disclosed as being critical, the solicitor cites *In re Bourdon*, 44 CCPA 740, 240 F.2d 358, 112 USPQ 323 ; *In re Selmi et al.*, 33 CCPA 1187, 156 F.2d 96, 70 USPQ 197 ; *In re Britton*, 28 CCPA 726, 115 F.2d 249, 47 USPQ 265 ; *In re Honnig*, 39 CCPA 740, 193 F.2d 191, 92 USPQ 135 ; *In re Shoemaker*, 23 CCPA 1033, 83 F.2d 288, 29 USPQ 209 ; and *In re Greider*, 29 CCPA 1079, 129 F.2d 568, 54 USPQ 139 . In *Bourdon*, *Britton* and *Shoemaker*, the issue was obviousness. Since the issue here is anticipation under 35 U.S.C. 102, we do not feel that the language of those cases is applicable. In *Selmi* the claimed ranges of components in an alloy steel actually fell within the ranges of components of a prior art steel. This case is different because the claimed range actually differs from the prior art range. In *Greider* and *Honnig*, the prior art showed a product similar to that claimed and having the same alleged properties. In both cases, the court refused to attach any significance to a claimed range without a showing that the range caused an improvement over the prior art product. We do not have that situation here because there is no indication that the glass composition of Lyle has desirable electrical insulating properties. Thus, we do not feel that the cases relied on by the solicitor permit us to disregard the 1 to 4% limitation as immaterial.

We agree with the solicitor that there is little support in the record for the range. In fact, as the solicitor has pointed out, there is no evidence in the record that the application as originally filed specifically contained the 1 to 4% limitation. This attack, however, appears to be directed to the sufficiency of the disclosure. Since no rejection under 35 U.S.C. 112 was made by the examiner, that issue is not now before us.

The claimed composition contains 1 to 4% K_2O , no sulfur, no carbon, and possesses insulating properties which, as far as the record indicates, have never been known in the prior art. The Lyle reference composition contains a small amount but likely less than 1% K_2O plus sulfur and carbon as essential components. It is an amber colored glass with no electrical insulating properties disclosed. In view of these many differences, we hold that the Lyle composition does not anticipate appellant's claims.

We do not feel that a rejection based upon the premise that the differences between appellant's glass and the Lyle glass are obvious can be sustained. Admittedly, the differences are small, but Lyle is devoid of any suggestion of a glass embodying these differences. The examiner has failed to suggest any reason for omitting carbon and sulfur from the Lyle glass. If one were making a colorless glass free of carbon and sulfur, there would be little reason for using the Lyle formula since it was primarily designed to enhance color stability. In the absence of any showing why it would be obvious to modify Lyle's glass, a "103 rejection" must be *reversed*.

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Our discussion has been directed primarily to claim 11, but the reasoning applies also to claim 5 which is narrower than claim 11 and which the board treated as not patentably distinct from claim 11.

The decision of the Board of Appeals is thus reversed.

- End of Case -